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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,697	01/27/2004	Robert Frederick	120137.481	2064

25096 7590 09/13/2006

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EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,697

Applicant(s)

FREDERICK ET AL.

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-92 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-92 are pending in this action.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a method for a computing system to provide an electronic marketplace for selling and purchasing Web services comprising registering web service providers, providing information to a consumer in response to a search request, creating a subscription for later use in response to a request to subscribe, and satisfying the request by interacting with the provider and providing to the consumer the receive response information, classified in class 705, subclass 26.
- II. Claims 16-92, drawn to methods and apparatuses for selling access to web services comprising registering web services, providing information about the service to consumers, performing a sale to consumer for access in response to requests, invoking the web service form the provider, providing response information to the consumer and providing payment to ser the provider based on the access fees, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as providing information regardless of

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whether a request received from a search, and providing payment to the provider based on paid access fees. See MPEP § 806.05(d). Furthermore, applicant indicates that these inventions are distinct (see Specification, page 13, ¶0031).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter and because a separate search would be required, restriction for examination purposes as indicated is proper.

SPECIES OF INVENTION I

This application contains claims directed to patentably distinct species. In the event applicant elects invention I, applicant must elect one of the following patentably distinct species.

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(1) Claims 1 and 2 are directed to an embodiment wherein after receiving payment from consumers, providing at least some of obtained payment to service provider (Spec., page 13, ¶0031).

(2) Claims 1 and 3 are directed to an embodiment wherein the payment by consumers includes receiving indications from consumers of an obligation to pay the specified use price (Spec., page 5, ¶0018).

(3) Claims 1 and 4 are directed to an embodiment including after registering web service, providing information to provider about use of web service by third-party consumers to allow provider to monitor service (Spec., page 8, ¶0025).

(4) Claims 1 and 5 are directed to an embodiment including notification requests from providers and/or consumers (Spec., page 9, ¶0026).

(5) Claims 1 and 6 are directed to an embodiment including after registering service and after invocation of service, receiving throttling instructions (Spec., page 4, ¶0016).

(6) Claims 1 and 7 are directed to an embodiment including registering a composite web service based on a request from a user (Spec., pages 9-10, ¶0027).

(7) Claims 1 and 8 are directed to an embodiment including receiving request from external consumer to execute logic specified in request indicating how and when to invoke multiple registered web services (Spec., pages 10-11, ¶0028).

(8) Claims 1 and 9 are directed to an embodiment wherein the electronic marketplace further employs one or more security measures (Spec., page 14, ¶0033).

(9) Claims 1 and 10 are directed to an embodiment wherein the subscription for one of registered service created is associated with an application program provided by consumer to other users (Spec., page 11, ¶0029).

(10) Claims 1 and 11 are directed to an embodiment wherein when each request is received from consumer to access service, denying that request unless specific use conditions are satisfied (Spec., page 14, ¶0033).

(11) Claims 1 and 12 are directed to an embodiment including satisfying request form consumer to access service without subscription (Spec., page 5, ¶0017).

(12) Claims 1 and 13 are directed to an embodiment wherein the information provided to consumer includes reviews (Spec., page 7, ¶0023).

(13) Claims 1 and 14 are directed to an embodiment wherein the electronic marketplace is part of a web store that offers multiple items other than services (Spec., page 8, ¶0024).

(14) Claims 1 and 15 are directed to an embodiment including registering multiple services available from an operator of the electronic marketplace (Spec., page 8, ¶0024).

The species are independent or distinct because they are subcombinations usable together that are not obvious variants, do not overlap in scope and have separate utility.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

SPECIES OF INVENTION II

This application contains claims directed to patentably distinct species. In the event applicant elects invention II, applicant must elect one of the following patentably distinct species.

(1) Claims 16-18 and 85-92 are directed to an embodiment wherein some registration requests include use conditions that must be satisfied, controlling of the access to a service with use condition is performed during the sale, and the sale is completed only if customer satisfied those conditions (Spec., page 6, ¶0019).

(2) Claims 16, 17, 19 and 85-92 are directed to an embodiment wherein the registration requests include requests to register composite services (Spec., page 10, ¶0028).

(3) Claims 16, 17, 20 and 85-92 are directed to an embodiment including receiving one or more coordination requests from users indicating multiple other registered services be accessed (Spec., page 11, ¶0029).

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(4) Claims 16, 21, 22 and 85-92 are directed to an embodiment wherein the received requests are sales are for an access subscription and the providing of access is performed only if consumer determined to have valid subscription (Spec., page 5, ¶0017).

(5) Claims 16, 21, 23 and 85-92 are directed to an embodiment wherein each performed sale for access subscription includes providing consumer with unique subscription ID (Spec., page 14, ¶0033).

(6) Claims 16, 21, 24, 28 and 85-92 are directed to an embodiment wherein each access subscription provides specified number of times, including a single one, for access (Spec., pages 4-5, ¶¶0016-0017).

(7) Claims 16, 21, 25 and 85-92 are directed to an embodiment wherein each access subscription provides specified period of time for access (Spec., pages 4-5, ¶¶0016-0017).

(8) Claims 16, 21, 26 and 85-92 are directed to an embodiment wherein at least some of access subscriptions are associated with an application specified by consumer (Spec., page 10, ¶0027).

(9) Claims 16, 21, 27 and 85-92 are directed to an embodiment wherein some of access subscriptions are associated with one or more affiliates other than consumer (Spec., pages 10, ¶0027).

(10) Claims 16, 29-33 and 85-92 are directed to an embodiment wherein each registration request from a service provider includes one or more use prices that are charged by the provider and the providing if information includes information on use prices (Spec., pages 4-5, ¶0016).

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(11) Claims 16, 34 and 85-92 are directed to an embodiment wherein one or more use prices associated with each service are based on specific quality (Spec., pages 12-13, ¶0031).

(12) Claims 16, 35 and 85-92 are directed to an embodiment wherein the performing of sales includes tracking access fees owed for each consumer (Spec., page 10, ¶0027).

(13) Claims 16, 36-40 and 85-92 are directed to an embodiment including allowing provider to monitor use of web services (Spec., page 12, ¶0030).

(14) Claims 16, 41 and 85-92 are directed to an embodiment including receiving notification requests from providers of web services (Spec., page 9, ¶0026).

(15) Claims 16, 42 and 85-92 are directed to an embodiment including receiving notification requests from consumers of web services (Spec., page 9, ¶0026).

(16) Claims 16, 43-46 and 85-92 are directed to an embodiment including receiving throttling instructions from the provider after registering and invoking services (Spec., pages 4-5, ¶¶0016-0018).

(17) Claims 16, 47 and 85-92 are directed to an embodiment including receiving throttle instructions from the consumer (Spec., pages 9-10, ¶0027).

(18) Claims 16, 48 and 85-92 are directed to an embodiment including receiving throttling instructions to restrict future invocations (Spec., page 5, ¶0018).

(19) Claims 16, 49-52 and 85-92 are directed to an embodiment including registering a composite web service indicating multiple other registered services and providing access to composite web service (Spec., pages 9-10, ¶¶0027-0028).

(20) Claims 16, 53-57 and 85-92 are directed to an embodiment including receiving a coordination request from a user indicating multiple registered services and satisfying the request by invoking multiple services and providing response information (Spec., page 11, ¶0029).

(21) Claims 16, 58-60 and 85-92 are directed to an embodiment wherein consumers are prevented from directly invoking registered web services, including employing security mechanisms (Spec., page 14, ¶0033).

(22) Claims 16, 61 and 85-92 are directed to an embodiment wherein the information provided to consumers about registered services is in response to search requests from consumers (Spec., page 7, ¶0022).

(23) Claims 16, 62 and 85-92 are directed to an embodiment including categorizing registered web services based on types of response information provided by the services and wherein the information is provided to consumers (Spec., page 7, ¶0022).

(24) Claims 16, 63 and 85-92 are directed to an embodiment including categorizing registered web services based on types of processing performed by the services and wherein the information is provided to consumers (Spec., page 7, ¶0022).

(25) Claims 16, 64 and 85-92 are directed to an embodiment including categorizing registered web services based on manners of invoking the services and wherein the information is provided to consumers (Spec., page 7, ¶0022).

(26) Claims 16, 65, 66 and 85-92 are directed to an embodiment wherein the information about registered web services includes recommendations (Spec., page 7, ¶0022).

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(27) Claims 16, 67 and 85-92 are directed to an embodiment wherein the information about services provided to consumers includes reviews of services (Spec., pages 7-8, ¶¶0023-0024).

(28) Claims 16, 68 and 85-92 are directed to an embodiment wherein the information about services provided to consumers includes ratings of services (Spec., pages 7-8, ¶¶0023-0024).

(29) Claims 16, 69 and 85-92 are directed to an embodiment wherein the information about services provided to consumers includes indications on usage (Spec., pages 7-8, ¶¶0023-0024).

(30) Claims 16, 70, 71 and 85-92 are directed to an embodiment wherein the information about services provided to consumers is provided in multiple web pages and includes descriptive information (Spec., page 8, ¶0024).

(31) Claims 16, 72-76 and 85-92 are directed to an embodiment including formatting response information before providing it to consumers (Spec., page 6, ¶0020).

(32) Claims 16, 77 and 85-92 are directed to an embodiment wherein the providing of access corresponds to prior invocations (Spec., pages 6-7, ¶0021).

(33) Claims 16, 78 and 85-92 are directed to an embodiment wherein the providing of access includes receiving requests from consumer for access and obtaining information to be provided by invoking services (Spec., page 10, ¶0028).

(34) Claims 16, 79, 80 and 85-92 are directed to an embodiment including selling points to a consumer for later use (Spec., pages 13-14, ¶0032).

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(35) Claims 16, 81-83 and 85-92 are directed to an embodiment wherein the method is performed by an organization unrelated to consumers (Spec., page 8, ¶0024).

(36) Claims 16 and 84-92 are directed to an embodiment including storing some of response information and providing access to the information without invoking the services (Spec., page 6, ¶0021).

The species are independent or distinct because they are subcombinations usable together that are not obvious variants, do not overlap in scope and have separate utility.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 16 and 85-92 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

September 9, 2006



Jeffrey A. Smith
Primary Examiner